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08/550,976

APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
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08/550,976 10/31/95 REDFORD

P M-2726-3DUS

EXAMINER

F3M1/0416

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ART UNIT 18 PAPER NUMBER

DATE MAILED: 3302

04/16/97

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

- ☒ Responsive to communication(s) filed on 10/31/95
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 35-55 and 97-99 is/are pending in the application.
- ☐ Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 35-55 and 97-99 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claims _____ are subject to restriction or election requirement.

Application Papers

- ☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☒ Notice of Reference Cited, PTO-892
- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2, 3 and 5
- ☐ Interview Summary, PTO-413
- ☒ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

-- SEE OFFICE ACTION ON THE FOLLOWING PAGES --

1. In response to the Amendments filed on October 31, 1995, claims 1-34, 56-96 and 100 have been cancelled and claims 35-55 and 97-99 are pending. In addition, applicant is informed that the search result, Exhibit "A", 37 pages and Exhibit "B", 48 pages in the information disclosure statement filed September 20, 1996 have not been considered by the examiner, where the 37 CFR 1.98 requirement is not met. Moreover, the U.S. Patent No. 4,855,725 in the information disclosure statement filed June 17, 1996 and one of the U.S. Patent No. 3,470,538 in the information disclosure statement filed September 20, 1996 have not been considered by the examiner, because they are the duplicate of the same patent cited in the information disclosure statements filed February 28, 1996 and September 20, 1996 and have been considered by the examiner.

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

3. The drawing are objected to by the Draftsman as being informal (see PTO-948). Correction is required.

Applicant is required to submit a proposed drawing correction in response to this Office action. However, correction of the noted defect can be deferred until the application is allowed by the examiner.

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4. Claims 45, 47, 48, 51 and 97-99 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claim 45, the antecedent basis for "said button code" has not been clearly set forth.

As per claim 47 and 48 the recitation therein is totally unclear in context and can not be fully comprehended without further clarification.

As per claim 51, the term "said button" should be recited as --said data button-- to clarify the confusion.

As per claims 97-99, the claimed structural elements do not provide the use of remotely controlling a host device. In other words, the functions performed by the various claimed structural elements can not perform the remotely controlling a host device function as claimed.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

6. Claims 46-48 and 99 as best understood are rejected under 35

U.S.C. § 102(e) as being anticipated by Yuen et al (U.S. Pat. No. 5,335,079).

As per claims 46-48 and 99, the broadly claimed structure can be interpreted as the apparatus and method using compressed codes for recorder preprogramming of Yuen et al. Figs. 1-28 of Yuen et al broadly discloses the remote control for remotely controlling a host device having the housing (12, 80, 90, 300) including storage media with data selecting content (380) for the data selecting association with electronic content accessible by the host device (14, 70, 370), remote control circuitry having the signal transmitter (390) including the infrared light emitting diode (28, 340, 342, 344, 346, 348) capable of transmitting the wireless signal for causing the host device to respond to a button code received from the remote control to record video, audio, picture and text, and the data button (20, 22, 24, 26, 27, 168, 170, 302, 306, 308, 310, 312, 316, 318, 320, 322, 324, 326, 328, 330) having the human understandable content association with the data selecting content of the housing.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. §103(c) and potential 35 U.S.C. § 102(f) or (g) prior art under

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35 U.S.C. § 103(a).

8. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 148 USPQ 459, that are applied for establishing a background for determining obviousness under 35 U.S.C. § 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or unobviousness.

9. Claims 35, 37, 41-45, 49, 50, 52-54, 97 and 98 as best understood are rejected under 35 U.S.C. § 103(a) as being unpatentable over Yuen et al (U.S. Pat. No. 5,335,079) in view of Shaw et al (U.S. Pat. No. 5,457,780).

As per claims 35, 37-45, 49, 50, 97 and 98, it is noted that the teaching of Yuen et al does not specifically disclose the holder capable of removably holding a storage media (as per claims 35, 49 and 97). However, Fig. 1 of Shaw et al broadly

discloses that such feature of the housing (116) having the holder capable of removably holding a storage media (126). Hence, it would have been obvious to one of ordinary skill in the art to modify the apparatus of Yuen et al with the feature of holder for removably holding a storage media as taught by Shaw et al as both Yuen et al and Shaw et al are directed to the remote control for remotely controlling the host device.

As per claims 38-40 and 52-54, it is noted that the teachings of Yuen et al and Shaw et al do not explicitly disclose the storage media is a flexible disk (as per claim 38), or an optical disk (as per claim 39), or a game cartridge (as per claim 40), the housing having the shape of a globe (as per claim 52), and the content representative of a component of the solar system (as per claim 53) as claimed. However, such limitations of the storage media is a flexible disk, or an optical disk, or a game cartridge, the housing having the shape of a globe, and the content representative of a component of the solar system are old and well known, and are considered an arbitrary obvious design choice, so as to provide different types of storage media and different shape of the housing with different type of data selecting content for remotely control the host device.

10. Claims 36 and 51 are rejected under 35 U.S.C. § 103(a) as unpatentable over Yuen et al (U.S. Pat. No. 5,335,079) in view of

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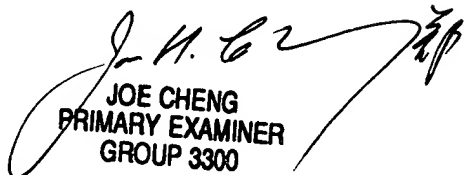
Shaw et al (U.S. Pat. No. 5,457,780) and further in view of Fernandez (U.S. Pat. No. 4,855,725).

As per claims 36 and 51, it is noted that the teachings of Yuen et al and Shaw et al do not explicitly disclose the touch panel. However, the teaching of Fernandez broadly discloses that such features of the button comprising the touch panel (36, 38) is old and well known. Hence, it would have been obvious to one of ordinary skill in the art to combine the remote control of Yuen et al and Shaw et al with the feature of the touch panel as taught by Fernandez as both Yuen et al, Shaw et al and Fernandez are directed to the remote control for remotely controlling the host device.

11. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

12. Any inquiry concerning this communication should be directed to Joe Cheng at telephone number (703) 308-0858.

Joe Cheng
April 13, 1997


JOE CHENG
PRIMARY EXAMINER
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